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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/458,132 02/16/00 SPRAGUE

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QM32/0803

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EXAMINER
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GEHMAN, R	
ART UNIT	PAPER NUMBER

3728

DATE MAILED:

08/03/01

*17*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/458,132

Applicant(s)

SPRAGUE ET AL

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001 and 06 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. This action supersedes the previous action mailed July 18, 2001.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Applicants' arguments generated consideration of the original disclosure of the originally filed specification as opposed to the substitute specification filed November 13, 1997, which added disclosure not originally described in the original filing of August 9, 1996. These issues need to be addressed, as they pertain to applicants' arguments.
3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 17 and 18 have been renumbered 16 and 17, respectively.
4. The new abstract of the disclosure is objected to because in lines 6-8, the descriptive sentence is new matter. See explanation below. Correction is required. See MPEP § 608.01(b).

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5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed nonconfidential printed data and printed interior (in abstract form such as by normal drafting means) must be represented. No new matter should be entered. The abstract presentation of printing should obviate any new matter.

6. The applicants have made numerous additions and deletions from the specification during prosecution, in most instances not employing the proper rules for reissue applications as set forth in 37 CFR 1.121(b). For example, the last amendment filed July 6, 2001, did not employ underlining of all additions from the originally issued patent and bracketing of all deletions from the originally issued patent in the substituted portions. In view of this, the original specification, which can not be substituted for, is difficult to understand as to what has changed and what is the same as the patent specification. **Applicants should review the state of the specification as to what is added and deleted with regard to the patent specification following the rules for reissue under 37 CFR 1.121(b) and have the specification be amended to be in appearance and form such that it conforms to the rules. Any subsequent amendment not conforming with the rules will not be entered.**

7. The amendment filed November 13, 1997 during original prosecution is objected to under 35 U.S.C. 132 because, contrary to applicants' notarized statement made at the time, it

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introduced new matter into the original disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which was not supported by the original disclosure is as follows: At column 2, line 17 of the specification, that the telephone rate information was to be provided in a list form. At column 2, line 18, that the instructions pertained specifically for use. At column 3, lines 49-52, that the printing can comprise a company logo. At column 4, lines 12-16, that the VMP was ever to be manufactured in the configuration of Figure 4 without the bottom perforated portion first existing. This last is most critical, as the original disclosure never disclosed that Figure 4 was to be made as a starting point, but rather arrived at after the removal of bottom side 25 from the original packaging 10 in use.

Applicant is required to cancel the new matter in the reply to this Office action.

8. The amendment to the reissue filing of December 9, 1999, made July 6, 2001, is objected to under 35 U.S.C. 251 because it introduces new matter into the disclosure. 35 U.S.C. 251 states that no amendment shall introduce new matter into the application for reissue. The Abstract in lines 6-8 recites an arrangement that was not described by applicants original disclosure of August 9, 1996 and comprises new matter.

9. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37

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CFR 1.175(a)(1) and MPEP § 1414. The specific error being relied on, that applicants failed to specifically claim the embodiment of Figures 4 and 5, is not described in the declaration.

Furthermore, there are additional errors now noted as to new matter added to the original specification filed August 9, 1996 during original prosecution.

10. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-4 and 16-17 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

11. Applicant's arguments filed June 28 and July 6, 2001 have been fully considered and found persuasive as to the construction of Figures 4-5 comprising a stand alone embodiment, but only commensurate with the original disclosure filed August 9, 1996. In that the specification is not in line with the arrangement of Figures 4-5 as supported by the original disclosure, it is still objected to. Furthermore, a consideration of the substitute

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specification filed November 13, 1997 indicates that, contrary to applicants sworn statement at that time, the substitute specification did contain recitation new to the original disclosure. Proper rejections in view of these have also been made.

12. This action is made non-final in view of the new new matter rejections now made.

13. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to the TC 3700 Customer Service Center at (703) 306-5648.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579 or (703)305-3580. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who

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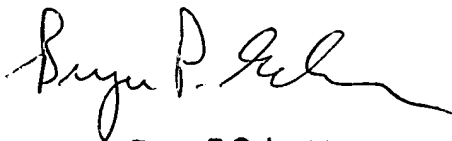
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authorize charges to a PTO deposit account. Please identify Examiner Gehman of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Bryon Gehman whose telephone number is (703) 308-3866.

BPG

August 2, 2001

A handwritten signature in black ink, appearing to read "Bryon P. Gehman", with a long horizontal flourish extending to the right.

**Bryon P. Gehman**  
Primary Examiner



**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.